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APPLICATION NO. 05/557,094	FILING DATE 04/15/97	DIAB	FIRST NAMED INVENTOR M	ATTORNEY DOCKET NO. 000100000
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QM41/0610

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WINAKUR, E
EXAMINER

ART UNIT 4/636

PAPER NUMBER

06/10/98 3

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/834,194

Applicant(s)

Diab et al.

Examiner

Eric Winakur

Group Art Unit

3736



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-30 is/are pending in the application

Of the above, claim(s) 1-14 is/are withdrawn from consideration

☒ Claim(s) 17 is/are allowed.

☒ Claim(s) 15, 16, and 18-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. This application contains claims directed to the following patentably distinct species of the claimed invention: I) the physiological monitor of the embodiment described on page 4, lines 19 - 27, and II) the physiological monitor of the embodiment described on page 5, lines 5 - 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. During a telephone conversation with Lee Henderson on May 13, 1998 a provisional election was made without traverse to prosecute the invention of Group II, claims 15 - 30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 - 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The information disclosure statement filed October 23, 1997 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Applicant notes that References N and O were not submitted in the instant invention, although they were submitted with a previous application 08/132,812. Although references cited in a parent case of a continuation or continuation-in-part need not be resubmitted in the child case, since the instant invention is not a continuation or continuation-in-part of the previous application, the references must be submitted to be considered. It has been placed in the application file, but the information referred to therein has not been considered.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15 - 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 15, the term "and" should be inserted at the end of line 4. With regard to claim 18, it appears that the term "comprising" (line 2) should read "having"; the term "and" should be inserted at the end of line 5. With regard to claim 29, a period (.) should be inserted at the end of line 7. With regard to claim 30, it appears that the term "comprising" (line 2) should read "having".

7. The following is a statement of reasons for the indication of allowable subject matter: Lo et al. teach a heart rate monitor that includes electrodes for detecting EKG and EMG signals, bandpass filters, analog-to-digital converters, and a digital signal processor to filter noise components of the signal and determine the heart rate. Diab et al. (U.S. Patent No. 5,490,505) and Tien (U.S. Patent No. 5,588,427) teach digital signal processing systems for use in oximetry systems. None of the prior art either alone or in combination, teaches or suggests, converting a detected waveform into a spectral domain waveform, identifying spectral peaks and peak frequencies, and applying rules to the identified peaks and frequencies to determine the pulse rate, as set forth in the claims.

8. Claim 17 is allowed.

9. Claims 15, 18, and 30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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10. Claims 16, and 19 - 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Winakur whose telephone number is (703) 308 - 3940. The examiner can normally be reached on Monday - Thursday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Bahr, can be reached on (703) 308- 1066. The fax phone number for this group is (703) 308 - 0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 - 0858.

Eric F. Winakur
Art Unit 3736
June 8, 1998

